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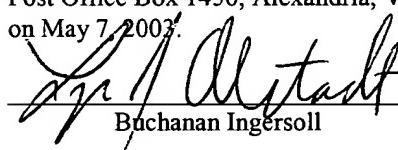
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Group Art Unit 3632) **PATENT APPLICATION**
Examiner J. Szumny)
In re application of) **SUCTION HOLDER**
William E. Adams III) **FOR RAZOR**
Serial No. 09/851,639)
Filed May 9, 2001)

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SUPPLEMENTAL BRIEF ON APPEAL

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Date: May 7, 2003



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REQUEST TO REINSTATE APPEAL

Pittsburgh, Pennsylvania 15219

May 7, 2003

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Office Action dated February 7, 2003, applicant requests that the appeal initiated by the Notice of Appeal dated June 3, 2002, be reinstated. A Supplemental Appeal Brief accompanies this request.

Applicant believes that no fee is due. Should any fee be due the Director is authorized to charge Deposit Account No. 02-4553.

Respectfully submitted,



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SUPPLEMENTAL BRIEF ON APPEAL

The real party of interest, related appeals and interferences and summary of invention are as set forth in the brief previously filed in this matter on August 12, 2002.

Status of Claims

Claims 1 through 11 are pending and on appeal. They are reproduced in the Appendix. Only claim 11 is different from the claims reproduced in the previously filed appeal brief.

Status of Amendments

The Examiner reopened prosecution in an Office Action dated September 30, 2002. Applicant filed an amendment to claim 11 on December 30, 2002. That amendment has been entered.

Issues

The issues on appeal differ somewhat from those listed in the previously filed brief. The Section 112 rejection was overcome and the Examiner no longer relies upon United States Patent No. Des. 388,271 to Moore. Instead, the Examiner now relies upon United States Patent No. 4,506,408 to Brown which the Examiner cited for the first time in the fourth and most recent Office Action. Therefore, the issues on appeal are:

1. Whether the Examiner erred in rejecting claim 11 under Section 102 based upon United States Patent No. 5,961,087 to Lee.
2. Whether the Examiner erred in rejecting claims 1-4, 6 and 7 under Section 103 based upon United States Patent No. 4,506,408 to Brown in combination with United States Patent No. 5,323,996 to Rendall.
3. Whether the Examiner erred in rejecting claim 5 under Section 103 based upon United States Patent No. 4,506,408 to Brown in combination with United States Patent No. 5,323,996 to Rendall, United States Patent No 5,313,734 to Roberts and United States Patent No. 6,131,865 to Adams.
4. Whether the Examiner erred in rejecting claims 8-10 under Section 103 based upon United States Patent No. 5,078,356 to Adams in combination with United States Patent No. 4,506,408 to Brown.

Grouping of Claims

The claims should be grouped as set forth in the previously filed brief. Claims 1 through 10 comprise Group I. Claim 11 is Group II.

ARGUMENT

I. Lee does not teach or suggest the holder of claim 11.

The Examiner rejected claim 11 under Section 102(e) as being anticipated by United States Patent No. 5,961,087 to Lee. At pages 4 through 9 of the previously filed brief, applicant explains why this rejection is erroneous and should be reversed. The Examiner contends elements 100 and 101 comprise a flag even though Lee says element 100 is a flagpole. Element 100 does not have a multi-sided cross-section and, therefore, does not meet the requirement of claim 11. There is no justification for reading a reference in contradiction to the express teachings of that reference. The Examiner erred in identifying element 80 in Figure 2 of Lee as a flagpole. If one measures the length and diameter of structure 80 in Figure 2 one finds that it has a diameter of 15 mm and length of 25 mm. As noted by applicant in the previously filed brief on appeal, a pole is defined as "A long, comparatively slender, piece of wood or metal." The Examiner is simply wrong in concluding that a structure 15 mm in diameter and 25 mm in length is a long, slender object.

II. It was improper to combine Brown, Rendall and Roberts.

United States Patent No. 4,506,408 to Brown discloses a ratchet hinge structure in which the two leaves or members of the hinge can be locked into one of several variable positions relative to one another. The patent is classified in Class 16, Miscellaneous Hardware, subclass 225. That subclass is directed to pliant or elastic hinges. The members of the Brown hinge are held together or apart at many different positions by meshing of webs and grooves of a female component with ribs and grooves of a male component. One or both sets of ribs and

grooves is made of a resilient plastic so that the ribs will deform and spring back to permit rotation of one member relative to another member. Col. 2, lines 29-66. Figure 9 shows an embodiment in which the male component has a hexagonal cross section but otherwise functions "in the same manner as disclosed with previous embodiments." "The protruding points 76 of the hexagon acts (sic) as ridges" and deform. Col. 4, lines 22-29.

Rendall in United States Patent No. 5,323,996 discloses a suction cup holder in which a ring or hook with a circular cross section is held within a bore of circular cross-section. There is nothing in this reference to teach or suggest that the ends of these rings and hook or the bore have a multi-sided cross-section.

United States Patent No. 5,313,734 to Roberts discloses a fishing rod holder having a mount 40 with a bore or barrel 46 that receives a post 36. The barrel has an undulating interior surface that mates with an undulating surface 38 on the post. Roberts teaches at column 2, lines 51-53 that "the holster can be rotated horizontally to different positions by withdrawing the undulating portion 38 from the undulating portions of the barrel." While the post and barrel could be viewed as having multi-sided cross-sections, Roberts teaches away from the requirement of applicant's claims that the multi-sided portion of split ring, hook or flag pole "can be rotated within the bore from a first position to a second position such that in each position every side of the end of the split ring (or hook or flagpole) is opposite a side of the at least one bore." The pole in Roberts can only be rotated after the undulating portion is withdrawn from the undulating portions of the barrel.

The combination of Brown with Rendall and Roberts is an improper combination of non-analogous art. One seeking to design a suction cup holder would likely consider other

suction cups. Therefore, pertinent prior art would include the cited Rendall patent which is classified in Class 248, Supports, subclass 315, Ring Type Hook and Adams '365 also in Class 248, but in subclass 206.2 for Bracketing Including an Annular Vacuum Cup. One skilled in the art might even look at holding devices used in combination with suction cups. But, it is unlikely that one skilled in the art would consider Roberts in Class 43, subclass 202.2 Holders and Supports for Fishing, Trapping and Vermin. Moreover, there is no reason or motivation that one skilled in the art would look at general hardware or hinges. This fact is confirmed by the failure of the Examiner to locate the Brown reference until the fourth Office Action. For this reason, the Examiner's rejection of claims based upon Brown in combination with Rendall and Roberts and/or Adams '356 is an improper combination of non-analogous art. Accordingly, the Examiner's rejection of claims 1 through 10 is erroneous and should be reversed.

III. The claims are patentable
even if the combination is proper.

The teaching of the prior art as a whole is that whenever a hook or pin is connected to the neck of a suction cup, the connection is made through a circular bore. Not only is a circular bore disclosed in Rendall and Adams '356, but also in all other prior art references of record that disclose attachment of a structure to the neck of the suction cup, except U.S. patent No. 3,237,330 which discloses a flat sign in a slot cut from the end of the neck. Those references are:

United States Patent No. Des. 174,366
United States Patent No. Des. 388,271
United States Patent No. 435,696
United States Patent No. 1,859,893
United States Patent No. 2,502,714
United States Patent No. 4,699,279

United States Patent No. 5,673,884
The catalogue received on December 13, 1990

The use of a ratchet connection can only be found in non-suction cup art.

Applicant has departed from this teaching and claimed a multi-sided structure that can be rotated within a bore in a suction cup, the bore having a complementary multi-sided cross-section. Applicant is able to do this through his use of a vinyl suction cup. The sides of the bore in the suction cup flex to allow rotation. This is opposite the action in Brown where the ridges or corners flex to allow rotation.

For a claim to be obvious from a prior art reference or combination of references, the reference or references must disclose each element of the claim and contain a teaching, suggestion or motivation to combine the references in manner to create the claimed invention. In re Sernaker, 702 F.2d 989, 995-996; 217 USPQ 1, 6 (Fed. Cir. 1983). It is wrong to use applicant's disclosure "as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the results of [applicants'] claims. * * Monday morning quarterbacking is quite improper when resolving the question of nonobviousness..." Orthopedic Equipment Co., Inc. et al. v. United States, 702 F.2d 1005, 1012; 217 USPQ 193, 199 (Fed. Cir. 1983).

None of the cited references teach a suction cup with a transverse bore having a multi-sided cross section. In all of the suction cups of the prior art that have a transverse bore, the bore is circular. The three references cited by the Examiner that disclose structures with bores having a multi-sided cross-sectional are not suction cups. Roberts discloses a molded plastic holder in which the post must be withdrawn from the mount to be rotated. Lee discloses a lever operated suction device in which a vacuum is produced by placing a rubber pad on a flat

surface and pulling a suction handle 40 to lift the center of the pad away from the surface. Brown discloses a hinge. None of the references suggests a multi-sided bore be cut through the neck of a suction cup to receive a similarly shaped end of a ring, hook or pole. One skilled in the art looking to design a suction cup holder would not consider the fishing pole holder disclosed by Roberts and likely would view Lee as following the prior art of placing a circular flagpole in a circular bore. The spring biased locking balls in the rotor of the Lee mechanism would be disregarded as too expensive and complicated as a way of holding a structure within a transverse bore through the neck of a suction cup. Indeed, Lee is attempting to solve the same problem as applicant, namely holding a flag in selected positions using suction. Yet, Lee created a complicated mechanism with at least fifteen pieces shown in Figure 2 to perform the same function as the one piece disclosed by applicant, a suction cup with a multi-sided transverse bore.

Particularly in light of Lee's disclosure, the Examiner has a burden of pointing to something in the suction cup references that would motivate one skilled in the art to turn to Brown's hinge or Roberts' fishing pole support and combine their teachings with Rendall or another suction cup reference to create the claimed invention. What the Examiner has done is found the elements of the claim in a group of unrelated prior art references, one for a suction cup, one for a fishing pole support, and one for a hinge.

The Examiner did not identify anything in any reference to provide an incentive or suggestion to modify the teachings of the cited references and reach the claimed invention. Instead, the Examiner resorted to speculation, unfounded assumptions and hindsight reconstruction. Such an approach is improper. The claims are patentable over the combination of Brown, Rendall and Roberts.

**IV. The combination of to Moore, Rendall, Roberts
and Adams '865 does not teach the holder of claim 5.**

The Examiner rejected claim 5 under 35 U.S.C. § 103 citing Adams United States Patent No. 6,131,865 in combination with Brown, Rendall and Roberts.

Claim 5 depends from claim 1 and requires that the suction cup be soft vinyl and the ring be polypropylene or polycarbonate. Adams '865 discloses a suction holder in which there is a vinyl suction cup having a transverse circular bore through the neck. A polycarbonate hook has a cylindrical portion that fits within the circular bore. Although Adams '865 discloses the materials set forth in claim 5, this reference does not supply the deficiencies noted in the combination of Brown, Rendall and Roberts. Instead, Adams '865 continues the practice of providing a circular bore and a circular cylindrical hook. Therefore, claim 5 is patentable over Brown in combination with Rendall, Roberts and Adams '865.

**V. The combination of Adams '356 with Brown
does not teach or suggest the holder of claims 8-10.**

The Examiner combined United States Patent No. 5,078,356 to Adams with the Brown reference to reject claims 8-10. Claim 8 is similar to claim 1 but requires a hook rather than a ring. Adams '356 discloses a suction cup with a hook passing through a transverse bore in the neck of the suction cup. Like the structures in most of the other cited references, the bore is circular and the hook is cylindrical. Thus, Adams '356 does not supply any of the deficiencies of the Brown reference discussed above. Consequently, claim 8-10 are patentable over the combination of Adams '356 with Lee.

CONCLUSION

The claims on appeal are patentable over each of the cited references and the teaching of the prior art as a whole. The rejections are based upon a misreading of the Lee reference, a combination of non-analogous art and hindsight. There is nothing in any of the cited references which teach or suggest

- (i) a transverse bore through the neck of a suction cup, the bore having a multi-sided cross-section;
- (ii) a portion of a hook having a multi-sided cross-section, or
- (iii) that the hook can be rotated within that bore in the neck of a suction cup from a first position to a second position such that in each position every side of the portion of the hook is opposite a side of the bore.

Reversal of the rejections and allowance of the appealed claims are respectfully requested.

Respectfully submitted,



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Date: May 7, 2003



APPENDIX

Claims on Appeal

1. A holder comprising:
 - (a) a suction cup having a cup portion, a neck containing at least one bore having a multi-sided cross section, and
 - (b) a split ring having two ends, said ends having a multi-sided cross-section complementary to the bore, each end sized and fitted within the at least one bore so that the split ring can be rotated within the bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore.
2. The holder of claim 1, wherein the multi-sided cross-section of the at least one bore and the multi-sided cross-section of the ends of the split ring are square.
3. The holder of claim 1, wherein the multi-sided cross-section of the at least one bore and the multi-sided cross-section of the ends of the split ring are hexagonal.
4. The holder of claim 1, wherein the multi-sided cross-section of the at least one bore and the multi-sided cross-section of the ends of the split ring are octagonal.
5. The holder of claim 1, wherein the suction cup is made of soft vinyl, and the split ring is made of one of polypropylene and polycarbonate.

6. The holder of claim 1 wherein the at least one bore is a single bore passing through the neck.

7. The holder of claim 1 wherein the at least one bore is a pair of bores on a common axis each bore extending from an outer surface of the neck toward a center of the next so that a web separates the two bores.

8. A holder comprising:

a. a suction cup having a cup portion and a neck extending from the cup portion, the neck containing a transverse bore having a multi-sided cross section, and

b. a hook having two ends, a portion of said hook adjacent one of said ends having a multi-sided cross-section complementary to the bore, said portion fitted within the bore so that the hook can be rotated within the bore from a first position to a second position such that in each position every side of the portion of the hook is opposite a side of the bore.

9. The holder of claim 8 wherein the hook is one of an eye hook and a J-hook.

10. The holder of claim 8 also comprising a head attached to the end of the hook adjacent the portion having a multi-sided cross section.

11. A holder and flag device comprising:
 - a. a suction cup having a cup portion and a neck extending from the cup portion, the neck containing a transverse bore having a multi-sided cross section, and
 - b. a flag having a display portion attached to a pole, at least a portion of said pole having a multi-sided cross-section complementary to the bore, said portion fitted within the bore so that the flag can be rotated within the bore from a first position to a second position such that in each position every side of the portion of the pole is opposite a side of the bore.